

 **Schultz & Associates, P.C.**
INTELLECTUAL PROPERTY ATTORNEYS



March 14, 2007

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Re: U. S. Patent Application Serial No. 10/734,461
"Method and Device For Preventing Pets From Clawing Home Furnishings"
Atty. Docket: 31960.0104

Sir:

Enclosed for filing are the following documents:

- 1) Appeal Brief;
- 2) Transmittal letter (in duplicate);
- 3) Check in the amount of \$250.00;
- 4) Certificate of Mailing by First Class Mail; and
- 5) A postcard receipt.

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Very truly yours,


George "Russ" Schultz

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: PEMBERTON, ET AL.

Serial No.: 10/734,461

Filed: 12/12/2003

For: METHOD AND DEVICE FOR PREVENTING PETS FROM CLAWING
HOME FURNISHINGS

Examiner: Mark A. Osele

Art Unit: 1734

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPEAL BRIEF

This is an appeal from the decision of the Primary Examiner in the Final Rejection dated September 25, 2006, finally rejecting claims 1-3, 42-45, and 47. This Brief is submitted with the statutory fee for a small entity in the amount of \$250.00.

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Real Party in Interest

The real party in interest is Bonnie Pemberton.

Related Appeals and Interferences

There are presently no appeals or interferences directly related to this appeal.

Status of Claims

The claims pending in this application are 1 - 3, 42 - 45, and 47. Claims 4 - 6, 16 - 41, 46, and 48 have been cancelled. Claims 7 - 15 have been withdrawn from consideration. Claims 1 - 3, 42 - 45, and 47 are appealed and are reproduced in the Claims Appendix. No claim is allowed.

Status of Amendments

No Amendment has been filed subsequent to the Final Rejection dated September 25, 2006.

Summary of the Claimed Subject Matter

The invention called for in the claims on appeal involves a device for deterring pets from scratching fabric of home furnishings (Independent claim 1) or from contacting soil (Independent claim 42) having strips with a first adhesive surface and a second adhesive surface, a transfer sheet or a corrugated substrate, and a release layer. Each of the strips has a length substantially greater than its width and is arranged side-by-side on the transfer sheet (§13, sentences 1-2, Ref. No. 13 of Figures 1 and 3). The strips have a first and a second adhesive surface on opposite sides (§13, sentence 4, Ref. Nos. 23 and 25 of Figure 2). The strips are releasably adhered to the transfer sheet or corrugated substrate on the first adhesive surface (§13, sentence 7). The release layers are releasably adhered to the second adhesive surface of the strips (§13, sentences 9 and 10) and are bisected along an axis parallel to the length of the strip (§13, sentence 11, Ref. No. 29 of Figure 1).

The strips are removed from the transfer sheet (§14, sentence 1) and releasably adhered to a home furnishing or plant (§14, sentences 3 and 4). Once the strips are in place, the release layers are removed to reveal an adhesive surface (§14, sentences 5 and 6, and Figure 3) of sufficient tack strength to cause a releasable sticking sensation (§14, sentence 9).

Grounds of Rejection to be Reviewed on Appeal

The grounds of rejection presented are:

1. Claim 42 as being anticipated under 35 U.S.C. 102(b) by the patent to *Hoogstoel et al.*
2. Claims 1 – 3 as unpatentable under 35 U.S.C. 103(a) over the Italian patent to *Avery Adhesive Label Corp.* in view of *Bode*, *Avery Dennison*, *Kriozere*, and *Ittershagen et al.*
3. Claims 43 - 44 as unpatentable under 35 U.S.C. 103(a) over the patent to *Hoogstoel et al.*
4. Claims 45 and 47 as unpatentable under 35 U.S.C. 103(a) over the patent to *Hoogstoel et al.* in view of *Bode* and *Kriozere*.
5. Claims 45 and 47 as failing to comply with the written description requirement under 35 U.S.C. 112, first paragraph.

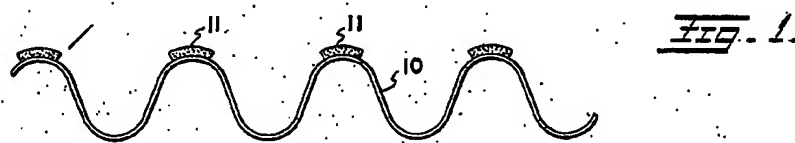
Appellants' Arguments

The final rejection includes one rejection under 35 U.S.C. 102(b), three rejections under 35 U.S.C. 103(a), and one rejection under 35 U.S.C. 112, first paragraph.

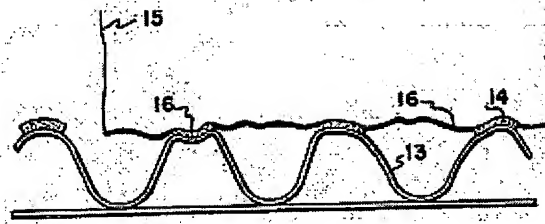
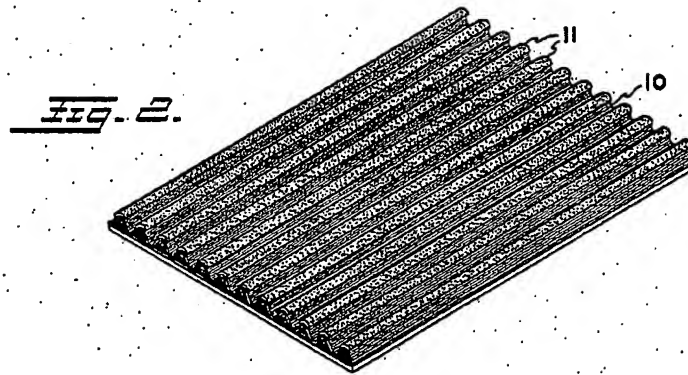
The rejection of claim 42 as being anticipated under 35 U.S.C. 102(b) by U.S. Patent No. 2,744,624 to Hoogstoel et al.

With respect to the rejection of claim 42 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 2,744,624 to *Hoogstoel*, Appellants respectfully traverse the rejection. The elements of claim 42 include a discrete layer (strip) having a corrugated substrate adhered to one side via a first adhesive surface and a release layer adhered to the opposite side of the strip by a second adhesive surface. *Hoogstoel* does not disclose a sheet with adhesive on opposing sides adhered to a corrugated substrate and a release layer. Rather, *Hoogstoel* only discloses a single coating of adhesive applied in lines to the ridges of a corrugated material and a removable sheet covering the lines of adhesive.

The *Hoogstoel* reference disclosed at most a single adhesive surface, not two adhesive surfaces as required by the claim (*see*, col. 2, line 38). As seen best in Figure 1 (below) it discloses an adhesive in lines along the top ridges of a corrugated board. (*see*, col. 2, line 42).



Further, the center layer in *Hoogstoel* is the corrugated layer, as opposed to the bottom layer being the corrugated layer as required by claim 42. Figures 2 and 3 below illustrate what is disclosed in the reference. Furthermore, *Hoogstoel* does not disclose the elements of claim 42 because claim 42 requires that the two adhesive surfaces be on the center (non-corrugated) layer which is releasably adhered to a bottom corrugated layer.



Further, still, as can be seen from Figures 2 and 3 and from col. 2, lns. 39-44, there is no adhesive on the bottom side of the corrugated material or the lower stiffening board disclosed by *Hoogstoel*.

Therefore, it is respectfully submitted that since *Hoogstoel* does not disclose all the elements required by claim 42 and that claim 42 is patentable over the art of record.

The rejection of claims 1 - 3 as unpatentable under 35 USC 103(a) over Italian Patent No. 590156 to *Avery Adhesive Label Corp.* in view of U.S. Patent No. 2,096,389 to *Bode*, Avery Index Maker Packaging to *Avery Dennison*, U.S. Patent No. 4,348,440 to *Kriozere*, and U.S. Patent No. 5,168,831 to *Ittershagen et al.*

With respect to the rejection of claims 1-3 under 35 U.S.C. §103(a) as being unpatentable over Italian Patent No. 590,156 to *Avery Adhesive Label Corp.* in view of U.S. Patent No. 2,096,389 to *Bode*, Avery Index Maker Packaging of *Avery Dennison*, U.S. Patent No. 4,348,440

to *Kriozero*, and U.S. Patent No. 5,168,831 to *Ittershagen et al.*, Appellants respectfully suggest that these claims are patentable and not obvious in view of the above references.

According to §2142 of the Manual of Patent Examining Procedure, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellants' disclosure.

At §2142 of the Manual of Patent Examining Procedures goes on to instruct:

To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention 'as a whole' would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the 'subject matter as a whole' of the invention. The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

One sign of a potentially defective obviousness rejection is the inclusion of separate references to represent each of the different features that describe in the claims of the application. In this situation, many times the claimed invention has been used as an instruction manual to piece together prior art that might render the claims obvious. In this process the examiner has lost sight of the real issue that is, whether it would have been obvious to combine the references

without having access to the application that is under examination to arrive at the claimed invention. *See, Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 221 U.S.P.Q. 1025, 1033 (5th Cir. 1984).

It is not correct for the examiner merely to focus on the differences between the prior art in the claimed invention and then state that the differences themselves are obvious. The claimed invention *as a whole* must be considered. Further, it is impermissible for the examiner to use the application itself as the basis or reason for formulating the obviousness rejection. As stated by the Federal Circuit:

It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This Court has previously stated that "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior to deprecate the claimed invention" *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2D 1780, 1784 (Fed. Cir. 1992).

The Federal Circuit has held that when more than one reference is required in establishing the obviousness rejection, it is necessary to ascertain whether the prior art teachings would appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitution or other modification. *In re Lalau*, 747 F.2d 703, 223 U.S.P.Q. 1257, 1258 (Fed. Cir. 1984). Furthermore, it is not enough for the examiner to present references that contain the assorted the features of the invention. The examiner must also show why it would appear that the references would have been combined. *See, in re Fritch*, 972 F.2d 1260. 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir. 1992) (The examiner can satisfy this burden only by showing some objective teaching in the prior art or that some knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references).

When the examiner proposes a combination that makes a prior art reference inoperable for its intended purpose, the resulting inoperable prior art reference may be considered to teach

away from the proposed combination, that is, not to teach the combination, thereby supporting a showing of non-obviousness. *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (Finding no suggestion to modify a prior art reference with a modification which would render the device inoperable for its intended purpose). For example, the Federal Circuit has stated:

We have noted elsewhere, as a ‘useful general rule’, that references that teach away cannot serve to create a prima facie case of obviousness....if references taken in combination will produce a ‘seemingly inoperable device’, we have held that such references teach away from the combination and thus cannot serve as predicates for prima facie case of obviousness.” *McGinley v. Franklin Sports, Inc.* 262 F.3d 1339, 60 U.S.P.Q.2D 1001, 1010 (Fed. Cir. 2001).

The suggestion to combine the references must not require substantial reconstruction or redesign of the references to arrive at the claimed invention. *In re Rattai*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959). *Also see, In re Sponnoble*, 405 Fed. 2d 578, 587, 160 U.S.P.Q. 237, 244 (CCPA 1969) (References taken in combination teach away because they would produce a seemingly inoperable device).

In our case, the Examiner has employed impossible hindsight to assemble many references to arrive at the claimed invention using the invention claimed by Appellants as a template. Moreover, the assemblage of references raised against the invention is unworkable and defeats the purpose of most if not all of the individual references.

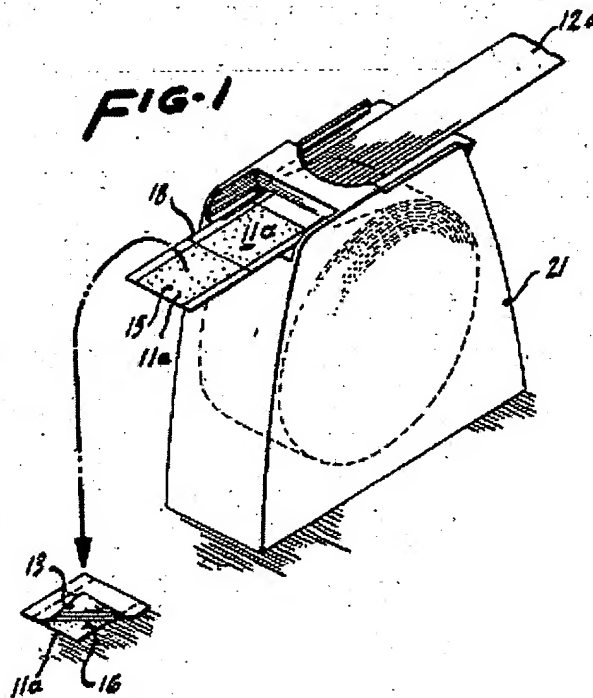
1. There is Insufficient Suggestion or Motivation to Combine *Avery Adhesive* with *Bode* and the References Teach Away from the Combination

The Examiner makes the observation that it would have been obvious to one of ordinary skill in the art at the time the invention was made to place the double-sided adhesive tapes of *Avery Adhesive* on a continuous, unperforated, planar transfer sheet such as those of *Bode* and *Avery Dennison* because it would be conventional and economical for handling, shipping, and

marketing. The Appellants respectfully submits that *Avery Adhesive* cannot be properly combined with *Bode* or *Avery Dennison*.

The problem that *Avery Adhesive* sought to solve was to provide a compact packaging for a roll of pressure sensitive adhesive tabs which can hold objects when mounting, such as mounting for photographs in an album or mounting signs on walls or other similar purposes.

A solution provided by the *Avery Adhesive* reference is that of providing a rolled strip of double-sided adhesive tabs arranged in succession, end-to-end in a sealed dispenser. (See, patent translation at p. 2, ¶3). *Avery Adhesive* discloses laminar composite strip **20** in rolled form in a dispenser **21**. (See, patent translation at p. 7, ¶2). Figure 1 (below) shows the invention. The continuous reinforcing strip **12a** extends from the strip and is doubled back around a pin in the dispenser so that when the reinforcing strip is pulled, the tabs **11a** and the reinforcing strips **10a** are separated from the top reinforcing strip **12a**. See, *Avery Adhesive*, p. 7. The tabs are then expelled from the dispenser. See, *Avery Adhesive*, p. 7.



In use, the tab is applied to a photograph. The reinforcing strip itself, **13**, sticks out from the side of the tab **11a** in such a way that it can be grasped and removed from the tab to as to expose the adhesive layer **16**. *See, Avery Adhesive*, p. 7.

Figures 5 and 6 show the way that the final invention of *Avery Adhesive* is manufactured. *See, Avery Adhesive*, p. 4. The figures show two cutting operations on one sheet of laminate material **10**. The laminate sheet makes one pass through a matrix roller cutter so that an incision is made through the reinforcing material **12** and the tab material **11** along a plurality of parallel cut lines **17** without making an incision in the reinforcing sheet **10**.

On the second pass, the laminate sheet is turned 90° and passed through another set of matrix cutting rollers which cut the reinforcing sheet **10** and the tab material **11** along the spaced parallel cut lines **18** arranged transversely with respect to the composite sheet without making incisions in the reinforcing sheet **12**. Neither Figure 2, Figure 5 nor Figure 6 show the final rolled product which is to be placed in the dispenser shown in Figure 1.

The principal aim of the *Avery Adhesive* invention is that of providing a strip of separate tabs arranged in succession, end to end, each of which has a coating of pressure sensitive adhesive on each side, and a continuous reinforcing material covering one side of the tabs, and the plurality of individual reinforcing strip pieces covering the other side *so that each of the individual reinforcing strip pieces completely covers a single tab and sticks out from it toward the outside*. *See, Avery Adhesive*, pp. 2-3. The goal of having a single tab with the reinforcing strip sticking out over its lateral edges is also repeated at p. 6, p. 7 and is a required element in many of the claims found in pp. 9-12.

United States Patent No. 2,096,389 to *Bode* discloses a decorative sticker used in the decoration of theatrical costumes. The invention of *Bode* is comprised of a flexible fabric body

(a “sticker”), with glitter or some other reflective material glued to one surface and a second surface treated with an adhesive and covered with a protective paper so that the paper can be removed and the “sticker” can be applied to a costume. P. 1, lns. 18-35.

Figure 1, below, shows the structure of the *Bode* device. The figure shows that glitter or other suitable material 14 is attached to top adhesive surface 13 while a backing 17 and 18 covers a bottom adhesive surface. See, col. 2, lns. 10-55, col. 3, lns. 1-2.

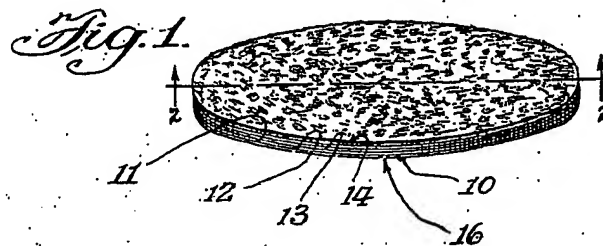


Figure 3, below, shows that *Bode* provides the backing 17 and 18 to be two pieces separated by a narrow slit 16 which allows the backing to be flexed in the center and bent back upon itself along slit 16. Col. 2, lns. 40-47. The backing is then grasped between the fingernails and pulled away from the adhesive which prevents the glitter 14 from flaking off around the edges. Col. 2, lns. 50-55.

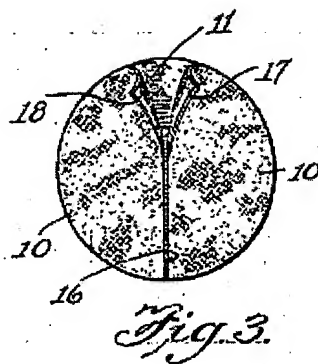
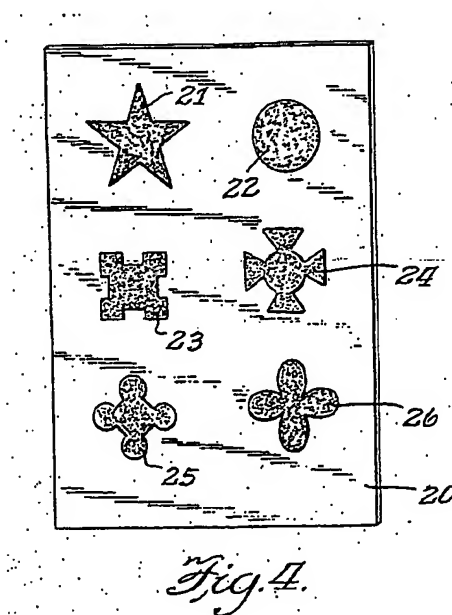


Figure 4, below, shows that *Bode* also discloses several decorated stickers temporarily adhered to a mounting card 20 which is an *alternative* to the use of the backing sheets 17 and 18. Col. 3, lns. 3-7. The embodiment shown in Figure 4 has the advantage, so *Bode* discloses, that it

serves to “unite” the stickers and makes for simple and economical handling and shipment of them. The advantage of economical handling and shipping applies to the embodiment shown in Figure 4 and not the embodiment shown in Figure 3.



A factor cutting against a finding of modification to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference may be said to teach away when a person or ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or be led in a direction divergent from the fact that the applicant took. *In re Gurley*, 27 F.3d 551, 31 U.S.P.Q. 2d 1130, 1131 (Fed. Cir. 1994). The degree of teaching away depends on the particular facts. However, a reference teaches away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the results sought by the applicant. *See, United States v. Adams*, 383 U.S. 39, 52, 148 U.S.P.Q. 479, 484 (1966) (“Known disadvantages in old devices which would naturally discourage the search for new inventions may be taken into account in determining obviousness”). *Also see, In re Caldwell*, 319 Fed. 2d 254, 256, 138 U.S.P.Q. 243, 245 (CCPA

1963) (Reference teaches away if it leaves the impression that the product would not have the properties sought by the applicant).

The invention of *Bode* cannot be combined with the invention of *Avery* because there is simply no suggestion or motivation to combine them and further the references teach away from the combination.

First, *Bode* does not disclose a double sided adhesive tape as advanced by the Examiner at p. 3, ln. 3 of the Office Action (“*Bode* shows a plurality of continuous unperforated double sided adhesive elements 21 and 26”). Rather, *Bode* only discloses a sticker having glitter adhered to one side and a second adhesive surface used to secure the sticker to a costume.

Second, there is no suggestion or motivation to combine the double sided elements of *Avery Adhesive* on a single backing sheet. *Avery Adhesive* teaches that strips are to be made from a continuous laminant and placed *in a dispenser on a roll*. It is not a fair reading of the *Avery Adhesive* reference to find that the double sided adhesive tabs would ever be shipped on a single flat backing sheet. Figures 2, 5 and 6 show intermediate processing steps to make the tabs of the invention, not the final invention itself. *These figures and the disclosure would lead one skilled in the art to believe the idea that Figure 1 depicted the final version of the invention and away from the idea that the intermediate steps to make the invention shown in Figures 5 and 6 depicted the final version of the invention.* Therefore, *Avery Adhesive* specifically and definitely teaches away from the placement of double sided elements on a planar sheet. There would be no motivation for one of ordinary skill in the art at the time the invention was made to stop short before the processing of the *Avery Adhesive* tabs was completed or backtrack to a flat version of the tabs after the final rolled version was made.

The Examiner also advances the argument that *Bode* shows that it is helpful to provide a slit on the center line of an unperforated backing sheet (“adhesive element”) so that the edges of the element are not damaged by force required on the edge from removing a backing sheet without a slit. From this disclosure, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to make a central slit in the release sheets of the double sided adhesive elements “of the references” because *Bode* teaches this location for a slit prevents damage to the peripheral edges.

The office action is unclear as to which of the “references” *Bode* is being combined with to arrive at the invention claimed by Appellants. Assuming for the sake of argument that *Bode* is being combined with *Avery Adhesive*, there is insufficient suggestion or motivation to combine the slit feature of *Bode* with *Avery Adhesive* to arrive at the invention of Appellants.

For example, to arrive at the invention of Appellants, the split release sheet of *Bode* (which is placed on the adhesive side of a *one-sided* decorative sticker) would need to replace the oversized top release sheet of *Avery Adhesive*. There would be no motivation to one of ordinary skill in the art at the time the invention was made to replace the oversized top release sheet of *Avery Adhesive* with the split release sheet of *Bode*.

The reason is clear from the *Avery Adhesive* disclosure. A principle aim of the *Avery Adhesive* invention was to provide a roll of strips placed end to end in a container *so that each of the backing strips completely covers a single tab and sticks out from it toward the outside*. See, *Avery Adhesive*, p. 3, ¶1. The necessity of the backing strip that “sticks out” from the side of the tab to the *Avery* invention is repeated at page 6, ¶2 (the last two lines) of *Avery Adhesive*. “Each reinforcing strip 10a completely covering a single tab 11a and *sticking out over its lateral edges*.” P. 6, ¶2. The “reinforcing tab 10a which protects the other side of the tab 10a, sticks out

from it toward the outside in such a way that it can be taken and removed from the tab so as to expose the adhesive layer. . .” P. 7, ¶2. Therefore, *Avery Adhesive* teaches that in order to achieve a tab that has an easily removable backing strip, the edges of the backing strip must be oversized and stick out past the tab body. The teaching of the edges of the backing strip being oversized eliminates any need for an inventor to seek any alternate method to facilitate removing the backing strip and teaches away from adding a slit in the middle of the backing strip.

Further, there would be no motivation to one of ordinary skill in the art at the time the invention was made to add expense and difficulty of manufacture to the *Avery Adhesive* disclosure. For example, if the two-sided release sheet as shown in Figure 3 of *Bode* were added to Figure 1 of *Avery Adhesive*, an additional cut would be required down the long axis of the roll of the sheet of the bottom layer 13. This additional cut would add manufacturing complexity and expense to the disclosure of *Avery Adhesive* without any significant benefit. It is submitted that one of ordinary skill in the art would not increase the expense and manufacturing complexity of the *Avery Adhesive* device merely to add the redundant advantage of a split release sheet on a tab which already had oversized edges to facilitate ease of removal.

Finally, there would be no motivation for one of ordinary skill in the art at the time the invention was made to combine alternative methods of the same *Bode* reference. For example, in order to arrive at the invention of Appellants, the split sheet release layer of *Bode* (Figure 3) would need to be combined with the planar transfer sheet of *Bode* (Figure 4) *at the same time*. Of course, this would defeat the very purpose of *Bode* because it would eliminate the possibility of having one side bear a decoration or glitter. One of ordinary skill in the art would simply not combine alternative features of the same reference at the same time, especially if the combination defeated the very purpose that the reference disclosed.

2. There is Insufficient Suggestion or Motivation to Combine *Avery Dennison* with *Avery Adhesive*.

The Examiner makes the observation that it would have been obvious to one of ordinary skill in the art at the time the invention was made to place the double sided adhesive tabs of *Avery Adhesive* on a continuous, unperforated, planar transfer sheet such as those of *Avery Dennison* because *Avery Dennison* shows that this arrangement is conventional for shipping and marketing of adhesive elements.

a. There is no Evidence of Public Availability of the References More than One Year Before the Priority Date.

As an initial matter, there is no evidence of record that the *Avery Dennison* reference was publicly available more than one year before the priority date of the Applicant. It is merely a package without a supporting declaration as to its accuracy or its availability.

A document to be considered a prior art publication needs to be accessible to the interested public. *Cooper Cameron Corp. v. Keaerner Oil Field Prds.*, 291 F.3d 1317, 62 U.S.P.Q. 2d 1846, 1851 (Fed. Cir. 2002). Appellants properly requested additional proof from the Examiner pursuant to § 1.104(d)(2) with respect to the rejection on March 9, 2007. Pursuant to § 1.104:

Whenever a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible and the reference much be supported, when called for by the Applicant, by an affidavit of such employee and such affidavit shall be subject to contradiction or explanation by the affidavits of applicant and other persons. 37 C.F.R. § 1.104(d)(2) (2002).

Because there is insufficient evidence of record indicating the public availability of the *Avery Dennison* reference, it should not be considered as a prior art reference sufficient to support a prima facie case of obviousness.

b. *Avery Dennison* Does Not Fairly Disclose the Elements Asserted.

Prior art may be considered not to teach an invention and thereby should fail to support an obviousness rejection when the stated objectives of the prior art support such an interpretation. *See, e.g., WMS Gaming Inc. v. International Game Tech.*, 184 F.3d 1339, 51 U.S.P.Q. 2d 1385 (Fed. Cir. 1999).

An invention is not obvious where one prior art reference teaches away from combination with a second or other prior art references. *In re Rudko*, Civ. App. No. 98-1505 (Fed. Cir. May 14, 1999)(Unpublished).

Proper motivation to combine references requires that the combination be desirable, not merely possible. *Winner International Royalty Corp. v. Wang*, 202 F.3d 1340, 53 U.S.P.Q. 2d 1580 (Fed. Cir. 2000), *cert denied*, 530 U.S. 1238 (2000) (One of ordinary skill in the art would not have reasonably elected to trade one feature of security versus another of convenience and therefore, the invention was not obvious).

The Office Action asserts that *Avery Dennison* discloses a continuous unperforated planar sheet including adhesive elements on a backing sheet including a plurality of rectangular adhesive elements side by side and parallel to the length of the elements on a planar unperforated sheet. However, *Avery Dennison* does not fairly disclose these elements. For example, nowhere in the *Avery Dennison* reference is a disclosure made of an “unperforated sheet”. The backing sheet of *Avery Dennison* could just as easily be perforated as unperforated given the disclosure of record.

The Examiner also asserts that *Avery Dennison* shows that “this arrangement” is conventional for shipping and marketing of adhesive elements. Assuming that “this arrangement” is a side by side placement of labels on a transfer sheet, the *Avery Dennison*

reference does not disclose that the arrangement is conventional for shipping or conventional for marketing of adhesive “elements”. There is no evidence of record to suggest otherwise.

c. There is Insufficient Suggestion or Motivation for the Combination of *Avery Dennison* with *Avery Adhesive*.

There is no explicit suggestion disclosed in *Avery Dennison* that would indicate to one of ordinary skill in the art at the time of the invention was made that anything other than a one-sided label could be placed on a backing sheet. In fact, *Avery Dennison* teaches away from such a suggestion because the stickers are advertised *as labels which are to be written on to identify files*. Obviously, if both sides of the *Avery Dennison* labels were covered with adhesive, it would be impossible to write on them and so defeat the very purpose of the labels disclosed.

For reasons much the same as those above with respect to the combination of *Avery Adhesive* with *Bode*, *Avery Dennison* cannot be combined with *Avery Adhesive*. For example, the Examiner suggests that the tabs of *Avery Adhesive* could be placed on the backing sheet of *Avery Dennison*. However, this argument requires a combination that no inventor would make based on the references. The disclosure of *Avery Adhesive* includes a strip of double sided tabs placed on a roll in a particular container so that the roll advances from the backing sheet as it is pulled. To place the tabs of *Avery Adhesive* on a backing sheet would defeat the purpose of *Avery Adhesive* because it would defeat the rolled form of the tabs and the special tab dispenser. There would simply be no motivation to one of ordinary skill in the art at the time the invention was made to modify *Avery Adhesive* to eliminate the very packaging advantages that it discloses.

Moreover, *Avery Adhesive* teaches away from the placement of double sided adhesive tabs on planar sheets because it teaches that the use of planar sheets is merely a manufacturing step during the process of manufacturing a roll of specially cut two-sided tabs to be rolled and placed in a roll dispenser. Initially during manufacture of the adhesive tabs, the tabs start out in

an uncut laminar sheet. The tabs are cut from the laminar sheet and are rolled in strips in order to easily store and protect the tabs before use and easily and quickly dispense the tabs when necessary. One of ordinary skill in the art would be taught to roll the tabs and use them in a dispenser rather than place them on an unperforated planar sheet.

3. There is Insufficient Suggestion or Motivation to Combine *Avery Adhesive* with *Kriozere*.

The Examiner argues that *Kriozere* shows that the backing sheet **16** and **18** of a rectangular adhesive element, **12** is slit along the central longitudinal axis, **20**, to aid in the alignment of the strip. The Examiner argues that it would have been obvious to one of ordinary skill in the art at the time the invention was made to make a central slit in the release sheets of a rectangular double sided adhesive elements “of the references” because *Kriozere* shows that a slit along the central longitudinal axis allows for alignment of a rectangular article.

A general relationship in the fields of prior art references to be combined is insufficient suggestion or motivation. *Interactive Techs., Inc. v. Pitway Corp.*, Civ. App. No. 98-1464, Slip Op. at 13, (Fed. Cir. G1 1999) (Unpublished), *cert denied* 528 U.S. 1046 (1999). The motivation or suggestion must be more closely targeted to the invention than a mere generally relationship between the prior art and the invention of applicant. *See, In re Alhamad*, Civ. App. 97-1345 (Fed. Cir. Dec. 18, 1997) (Unpublished) (Holding that a general relationship between strength reinforcing was not sufficient suggestion of a fire resistance goal of the invention).

An invention is not obvious, but is a combination of old elements if the old elements typically deal with different problems. *Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 Fed. 2d 1452, 221 U.S.P.Q. 41 (Fed. Cir. 1984) (Holding that an invention combining a single process to process light and heavy gauge metal scrap objects nonobvious for

combining two different known features in a single device when the known features solved different problems).

As an initial matter, the Office Action is unclear as to which of the “references” *Kriozere* is being combined with to arrive at the invention of Appellants. It is submitted that *Bode* does not disclose a double sided adhesive element but rather a single sided adhesive element with a decorative material glued to the other side. Because *Bode* does not disclose a double sided adhesive element, its combination with *Kriozere* does not disclose all the elements of the claimed invention and so fails to make out a prima facie case of obviousness.

Assuming then that the “references” of the double sided adhesive elements “of the references” refers to *Avery Adhesive*, it is submitted that there is insufficient suggestion or motivation to make the combination.

The *Kriozere* reference provides a pressure sensitive tape used in sealing the open end of sterilized pouches. The central feature of the *Kriozere* reference is the “adhesive to adhesive contact” around the open end of a sterilized pouch ensuring that no contamination will reach the pouch interior. *Kriozere* at col. 1, lns. 53-61. The *Kriozere* reference discloses only a single sided tape which essentially is folded over onto itself after being positioned on an open sterilized pouch. Once sealed, there is no adhesive side remaining, only a smooth adhesive free closure to the medical pouch.

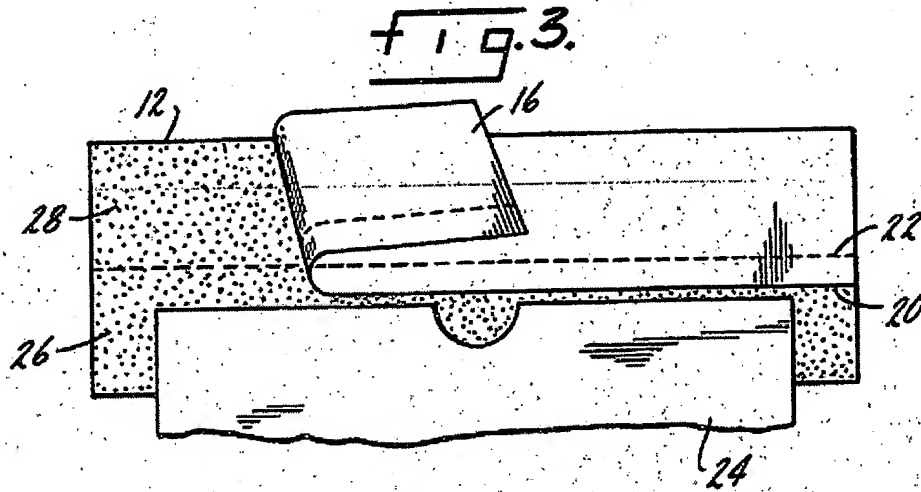
For the reasons stated above with respect to the split release sheet of the *Bode* reference, there is no suggestion or motivation to combine the split release sheet of the *Kriozere* reference with the *Avery Adhesive* reference. The reason is that the *Avery Adhesive* invention already provides for an oversized release sheet which extends beyond the edges of the tab, facilitating easy release. There is no motivation to duplicate the ease of release feature of the *Avery*

Adhesive disclosure by adding the additional slit in the release sheet as discussed by *Kriozere*. Moreover, adding the additional slit in the release sheet would increase the manufacturing cost and complexity of the *Avery Adhesive* invention and so would lead away from the combination with *Kriozere*.

There is also insufficient suggestion or motivation because the suggestion or motivation advanced by the Examiner, namely that *Kriozere* shows the slit along the central longitudinal axis allows for “alignment” of a rectangular article, does not offer any advantage whatsoever in the context of the *Avery Adhesive* disclosure. Referring to Figure 3 below from *Kriozere*, it can be seen that the “positioning” referred to by the *Kriozere* reference is the positioning of the fold line 22 with respect to the open end of the pouch to be sealed 24. The pouch 24 is positioned on the lower side of adhesive 26. Then the release sheet 16 is pulled, facilitating the adhesive side 28 being folded down onto the adhesive side 26, forming an adhesive seal all the way around the end of the open bag. However, in the context of the *Avery Adhesive* device, the positioning of the tab would not be facilitated *at all* by a two-piece release layer. For example, when the adhesive tab of *Avery Adhesive* is stuck to a surface as shown in the left hand portion of Figure 1, one side of the adhesive is already exposed (11a). The alignment of the adhesive side which is face down takes place by positioning the edges of the oversized release sheet against the back of the photograph. Altering the structure of the release sheet would not change or help how this positioning was done so there is no advantage offered by the combination of the references.

Further, if a double sided release sheet were placed in position of the single release sheet 13 of *Avery Adhesive* and one side removed as disclosed by Figure 3 of *Kriozere*, the difficulty in positioning the tab of *Avery Adhesive* would not be decreased but rather increased because both

sides of the adhesive would be exposed once, causing the tab to stick to the fingers of the user during placement on the back of the photograph.



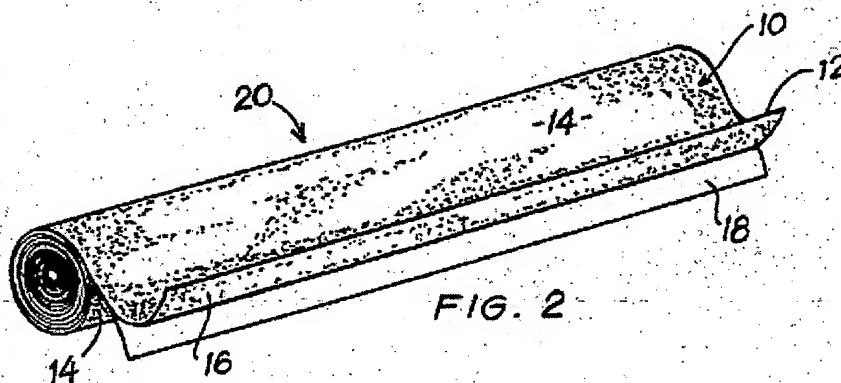
From yet another perspective, the double sided release sheet of *Kriozere*, if used to replace the single sided release sheet 13 of *Avery Adhesive*, would not be useful to position the article because when they were removed, the tabs would be behind the photograph and already attached to the photograph. The photograph would be aligned on the wall, therefore, the tab would not be visible to the user and alignment of the tab would not be possible (or necessary). For these reasons, there would be no motivation or suggestion to one of ordinary skill in the art at the time the invention was made to apply the split release sheet of *Kriozere* to the disclosure of *Avery Adhesive*.

4. There is Insufficient Suggestion or Motivation to Combine *Avery Adhesive* with *Ittershagen*.

The Examiner makes the further observation that it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the double-sided adhesive element of the “references as combined above” transparent and with tack strength to releasably adhere to an animal such as disclosed in *Ittershagen*. The Appellants respectfully submit that the

previous references cannot be properly combined with *Ittershagen* because there is no suggestion or motivation to do so and further there is no reasonable expectation of success.

The *Ittershagen* patent discloses a single wide sheet of transparent flexible material covered on both sides with an adhesive substance and on one side with a protective backing. *Ittershagen*, col. 3, lns. 1-12 and lns. 38-41. *Ittershagen* also discloses that the top layer consists of a stronger adhesive than the bottom layer and further provides two separate adhesive products for the top and bottom adhesive layers. Col. 3, lns. 20-39. As shown in Figure 2 below, the *Ittershagen* device is manufactured on a roll for ease of storage and transportation. Col. 3, lns. 42-45. The weaker adhesive is placed down and toward the floor and the stronger adhesive is left exposed on top.



An invention is not obvious where one prior art reference teaches away from combination with a second or other prior art references. *In re Rudko*, Civ. App. No. 98-1505 (Fed. Cir. May 14, 1999)(Unpublished).

Proper motivation to combine references requires that the combination be desirable, not merely possible. *Winner International Royalty Corp. v. Wang*, 202 F.3d 1340, 53 U.S.P.Q. 2d 1580 (Fed. Cir. 2000), *cert denied*, 530 U.S. 1238 (2000) (One of ordinary skill in the art would

not have reasonably elected to trade one feature of security versus another of convenience and therefore, the invention was not obvious).

There is insufficient suggestion or motivation to combine the *Ittershagen* reference with any of the references cited by the Office Action.

For example, the *Avery Adhesive* reference is used to hold objects when mounting, as for example, for mounting photographs in an album or for mounting signs on walls (*See*, patent translation at p. 2, ¶2). The examples of uses disclosed in the specification indicate the adhesive is not releasable, ostensibly so that the signs do not fall off the wall. If the tack strength were reduced to where the adhesive tabs of the *Avery Adhesive* reference were “releasable”, the tabs would no longer function according to their designed purpose of holding objects and there would be no reasonable expectation of success. As a result, *Avery Adhesive* teaches away from a tack strength of releasable adhesion as disclosed in *Ittershagen* and therefore the combination of the two references is improper.

It is also insufficient suggestion or motivation to combine the *Ittershagen* reference with *Avery Adhesive* because there would be little if any use to the transparency of *Ittershagen* in *Avery Adhesive*. *Avery Adhesive* is an invention designed to be used on photographs to be put in a scrapbook or on the wall. There would be no motivation to make the *Avery Adhesive* tabs transparent because they would be covered by the photograph in either use. One of ordinary skill in the art at the time the invention was made would have no motivation to make the *Avery Adhesive* tabs invisible.

Additionally, the *Ittershagen* reference itself teaches away from a combination with *Avery Adhesive* because the single strip of double sided adhesive tape disclosed in *Avery Adhesive* would be of insufficient size to fulfill the goals of *Ittershagen*. One of the goals of

Ittershagen was to create a device that could be placed on the floor around an area or an object desired to be kept off limits to pet animals. Col. 1, Ins. 61-63. Figure 3 of the *Ittershagen* patent shows use of the device being at least many inches wide. See, Figure 3 at 10. Another objective of the *Ittershagen* device was to create an apparatus that could be tailored to a particular geometry of the area or object chose for protection. Col. 1, Ins. 63-65. In order to tailor the sheet of *Ittershagen*, it is disclosed at col. 3, Ins. 55 and following that the material is peeled off the roll and then cut to conform to the area in which it is intended. An example width is provided at col. 4, Ins. 18-20 as approximately 12 inches wide.

These goals of *Ittershagen* indicate that a very wide material is used in comparison to *Avery Adhesive*. One of ordinary skill in the art at the time the invention was made would not consider using the dispensing apparatus of *Avery Adhesive* because to dispense a product as wide as *Ittershagen* would be unwieldy. Furthermore, it is submitted that the great width of the release sheet required would make the dispensing package of *Avery Adhesive* unworkable to dispense the adhesive sheet material. Because the package would be unworkable in light of the goals of *Ittershagen*, there is insufficient suggestion or motivation to combine the references.

5. There is Insufficient Suggestion or Motivation to Combine *Ittershagen* with *Bode*.

The *Bode* reference provides an ornamental sticker for the decoration of a costume. The *Bode* reference comprises a flexible fabric with a decorative material (like glitter) glued to one of the adhesive surfaces and an adhesive with a backing adhered to the other (*Bode* at p. 1, col. 1 at lines 19 – 33). The glitter is pressed into the glue to obtain a strong adhesion (*Bode* at p.1, col. 2 at lines 24 – 25). If the tack strength of the glue were reduced, the invention would cease to function as intended because either the glitter would come off of the sticker or the sticker would come off of the costume. As a result, *Bode* teaches away from a tack strength of releasable

adhesion as disclosed in *Ittershagen* and therefore the combination of the two references is improper.

Furthermore, one of ordinary skill in the art at the time the invention was made would not be lead to combine *Ittershagen* with *Bode* because the advantage of *Ittershagen* would be lost if the combination was made. In operation, the advantage of *Ittershagen* is the exposed adhesive surface used to deter pets. However, the *Bode* patent teaches that the second adhesive surface must have a decorative material placed in it with strong adhesion. Obviously, if the second adhesive surface of *Ittershagen* had a decorative material placed in it, it would be ineffective to produce a sticking sensation because no adhesive surface would be exposed.

6. There is Insufficient Suggestion nor Motivation to Combine *Ittershagen* with *Avery Dennison*.

One of ordinary skill in the art at the time the invention was made would not combine the device of *Avery Dennison* with the device of *Ittershagen* because there is not sufficient suggestion or motivation to do so.

The *Avery Dennison* reference provides adhesive labels for labeling file folders or indexes. The instructions on the packaging indicate a user is to write on one side of the labels and affix the labels to a folder using the single adhesive surface. The labels are used for identification and organization. But if the strips were only releasably secured as suggested by the releasable adhesive of *Ittershagen*, the labels would come off and the identity of the files would be lost. The purpose of the labels would be defeated.

Further, the single adhesive surface of *Avery Dennison* is designed to adhere to a folder, leaving the non-adhesive side exposed as a label. A non-sticky label defeats the purpose of the exposed adhesive surface of *Ittershagen* which is designed to remain exposed to repel animals. As a result, the *Avery Dennison* reference teaches away from an exposed adhesive surface and a

low adhesive strength as disclosed in *Ittershagen* and therefore the combination of the two references is improper.

Still further, the *Ittershagen* reference must be deployed from a rolled form because it has a single backing sheet. Therefore, in order to protect the adhesive surfaces, the single backing sheet must be in contact with both adhesive surfaces. The only way to do this is to have the sheet deployed on a roll. If the *Ittershagen* device was marketed in a flat sheet as shown by *Avery Dennison*, the product would be shipped with an exposed adhesive surface sticking to the interior of the packaging and making the device inoperable. Moreover, if the *Avery Dennison* stickers were sold in rolled form, then unrolled, they would be difficult to write on or use as labels because of the residual curl of the paper. Therefore, *Avery Dennison* leads away from a rolled deployment as required by *Ittershagen*.

7. There is Insufficient Suggestion or Motivation to Combine *Ittershagen* with *Kriozere*.

The *Kriozere* reference provides a pressure sensitive seal member used in sealing the open end of sterilized pouches. The essential feature of the *Kriozere* reference is the adhesive-to-adhesive contact around the open end of the pouch insuring that no contamination will reach the pouch interior (*Kriozere* at col. 1, lines 53 – 61). Releasable adhesion such as suggested by *Ittershagen* would weaken the seal, thereby increasing the possibility of contamination and rendering the invention useless. Therefore, the combination of the two references is improper because the use of *Ittershagen* would lead one of ordinary skill in the art away from the invention of *Kriozere*.

The rejection of claims 43 - 44 as unpatentable under 35 USC 103(a)
over U.S. Patent No. 2,744,624 to *Hoogstoel et al.*

With respect to the rejection of claims 43 – 44 under 35 U.S.C. §103(a) as being

unpatentable over U.S. Patent No. 2,744,624 to *Hoogstoel et al.*, Appellants respectfully suggest that these claims are patentable and not obvious under *Hoogstoel et al.*

As discussed above, claim 42 is not anticipated by the patent to *Hoogstoel et al.* because *Hoogstoel* does not disclose all of the limitations required by the claim. Claims 43 and 44 depend from claim 42; therefore the discussion above with respect to claim 42 also applies to claims 43 and 44. According to the Manual of Patent Examining Procedures §2142, to establish a prima facie case of obviousness, the prior art reference or references when combined must teach all the claim limitations. More specifically, *Hoogstoel* discloses only thin lines of adhesive applied to the ridges of a corrugated material. *Hoogstoel* does not disclose a sheet with adhesive on both sides protected by release sheets as required by the claims of Appellants. Since the cited reference does not teach all the limitations of claim 42, it does not teach all the limitations of claims 43 or 44. Claims 43 and 44 are submitted to be nonobvious and patentable.

The rejection of claims 45 and 47 as unpatentable under 35 USC 103(a) over U.S. Patent No. 2,744,624 to *Hoogstoel et al.* in view of U.S. Patent No. 2,096,389 to *Bode* and U.S. Patent No. 4,348,440 to *Kriozere*

With respect to the rejection of claims 45 and 47 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 2,744,624 to *Hoogstoel et al.* in view of U.S. Patent No. 2,096,389 to *Bode* and U.S. Patent No. 4,348,440 to *Kriozere*, Appellants respectfully suggest that these claims are patentable and not obvious under *Hoogstoel et al.* in view of *Bode* and *Kriozere*.

As discussed above, claim 42 is not anticipated by *Hoogstoel*. Because claim 45 depends from claim 42 and claim 47 depends from claim 45, the discussion above with respect to claim 42 also applies to claims 45 and 47. According to the Manual of Patent Examining Procedures §2142, to establish a prima facie case of obviousness, the prior art reference or references when

combined must teach or suggest all the claim limitations. *Hoogstoel* does not disclose all the limitations of claim 42. *Hoogstoel* discloses one thin coating of adhesive applied in lines to the ridges of a corrugated material. *Hoogstoel* does not disclose a sheet with adhesive on both sides protected by two release sheets as required by the claims. The combination of *Bode* and *Kriozere* does nothing to cure the deficiencies of *Hoogstoel* regarding the limitations contained in claim 42 because *Bode* only discloses a single exposed adhesive surface, not two exposed adhesive surfaces as required by the claims. Claims 45 and 47 require all the limitations of claim 42. Since the references cited do not suggest or disclose all the limitations of the claims, alone or in combination, claims 45 and 47 are patentable.

The rejection of claims 45 and 47 as failing to comply with the written description requirement under 35 USC 112, first paragraph

With respect to the rejection of claims 45 and 47 under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement, Appellants respectfully assert that the written description requirement has been met.

Support for the elements of claim 45 can be found in Figure 2 which shows release layer 27 separated into two removable portions by cut 29. The two portions abut but do not overlap the central longitudinal axis of strip 21. Figure 2 clearly shows the two portions of release layer 27 adjacent to one another but not overlapping one another. Further support for the elements of claim 45 is described in the last sentence of paragraph 13 where release layer 27 is longitudinally bisected into two portions by cut 29. Support for the elements of claim 47 can be found in Figures 1 and 2 which show a plurality of strips 13 placed side by side separated by gaps 17. The gaps between the strips are fairly shown in the drawings to be substantially less wide than the strips themselves. Additional support describing the strips and the gaps that separate them is found in the third sentence of paragraph 13. The strips are described as uniformly spaced apart

from one another by gaps. Further support can be found in the second sentence of paragraph 14 where gaps 17 between strips 13 provide an indication of the side margin of each strip 13. The subject matter of claims 45 and 47 is fairly described in the specification and drawings in such a way as to reasonably convey its meaning to one of ordinary skill in the relevant art and to indicate that Appellants had possession of the claimed invention.

Appellants Have Submitted Convincing Declarations and Other Evidence of Secondary Considerations of Non-Obviousness Sufficient to Overcome the Obviousness Rejections.

The presentation of evidence of secondary considerations is often the key to overcoming an obviousness rejection. For example, the Federal Circuit has held that

Evidence of secondary considerations may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to have been obvious in light of the prior art was not. It is to be considered as part of all the evidence, not just when the decision maker remains in doubt after reviewing all the art. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538-40, 218 U.S.P.Q. 871, 879 (Fed. Cir. 1983).

In a crowded field, such as that presented by the prior art in this case, small differences may make all the difference as to non-obviousness. For example, the Federal Circuit recognized this principle as follows:

Thus when differences that may appear technologically minor nonetheless have a practical impact, particularly in a crowded field, the decision-maker must consider the obviousness of the new structure in this light. Such objective indicia as commercial success, or filling an existing need, illuminate the technological and commercial environment of the inventor, and aid in understanding the state of the art at the time the invention was made. *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 20 U.S.P.Q. 2d 1746, 1752 (Fed. Cir. 1991).

When evidence of secondary consideration exists, it is always to be considered, not merely when the Examiner remains in doubt after reviewing all the prior art. *Cable Elec. Prods., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 U.S.P.Q. 887 (Fed. Cir. 1985).

An applicant need not show that all possible embodiments within the claims are successfully commercialized in order to rely on the success of the marketplace of the embodiment that was commercialized. *Applied Materials, Inc. v. Advance Semiconducting Materials Amc.*, 98 F.3d 1563, 40 U.S.P.Q. 2d 1481, 1486 (Fed. Cir. 1996), *cert denied*, 117 S.Ct. 1822 (1997). The Board has recognized that if the commercial success is due to the merits of the claimed invention, the evidence of nonobviousness is to be accorded substantial weight. *Ex parte Remark*, 15 U.S.P.Q.2d 1498 (B.P.A.I. 1990).

The Federal Circuit has held that a *prima facie* case of nexus is made out when the patentee shows that there is commercial success, and the product or method that is commercially successful is the invention disclosed and claimed in the patent. *Demaco Corp. v. F. von Langsdorf Licensing Ltd.*, 851 F.2d 1387, 7 U.S.P.Q. 2d 1222, 1226 (Fed. Cir. 1988). A patentee is not required to prove as part of its *prima facie* case that the commercial success of the patented invention is not due to factors other than the patented invention. It is sufficient to show that the commercial success was of the patented invention itself. A requirement for proof of the negative of all imaginable contributing factors would be unfairly burdensome, and contrary to the ordinary rules of evidence. *Id.* at 1226-27.

A patent owner's lack of previous experience in a relevant market combined with high sales volume of the product provides an inference of a nexus between a commercial success and the patented invention and are probative evidence of nonobviousness. *Pro-Mold & Toll Co. v. Great Lake Plastics, Inc.*, 75 F.3d 1568, 37 U.S.P.Q. 2d 1626 (Fed. Cir. 1996). The Federal Circuit pointed out specifically in this case that the lack of market power in a field suggests that the novel features of the patented invention led to the commercial success.

Industry recognition is also probative in nonobviousness when related to the claimed invention. *In re Metz*, 173 F.3d 433 (Fed. Cir. 1998) (unpublished).

A combination of commercial success and copying by an infringer provides strong evidence of secondary consideration supporting a decision of nonobviousness. *Heidleberg Harris, Inc. v. Mitsubishi Heavy Industries, Ltd.*, Civ. App. No. 99-1100, 2000 U.S. App. LEXIS 23757, *30 (Fed. Cir. Sept. 18, 2000) (unpublished). If the evidence of copying includes reports indicating that the infringer followed the patentee's design and advertisement, these form an extremely persuasive indication of nonobviousness. *Id.* at *29-*30.

In this case, Appellants provide the Declaration of Ms. Bonnie Pemberton, the inventor, (filed on September 6, 2006) and the Declaration of Mr. Chris Ruben, a sales executive familiar with the products incorporating the invention (filed on September 6, 2006) as evidence of several secondary considerations that indicate that the invention is not obvious. Furthermore, Appellants provide the Supplemental Declaration of Bonnie Pemberton (filed on March 12, 2007).

Ms. Pemberton testifies that from humble beginnings, the product incorporating the claimed invention rose from 0% market share to controlling almost 80% of the market share available. *See*, Declaration of Bonnie Pemberton at ¶8. The Declaration of Mr. Chris Ruben at ¶4 concurs. Ms. Pemberton further testifies that the details of market share, including the approximately size of the market and her percentage of sales. *See*, Declaration of Bonnie Pemberton at ¶¶7-8. She also testifies that her product incorporating the claimed invention was a replacement of the prior art which was greeted well by customers who voiced to her the advantages of the claimed features, including but not limited to, the features of the multiple layers, the bisected release layer and that the strength of the adhesive is sufficient to cause an unpleasant sticking sensation to pets. *See*, Declaration of Bonnie Pemberton at ¶¶ 9-11.

Additionally, customers have also voiced their opinions on the advantages of the corrugated embodiment; specifically, the corrugated substrate that contains an adhesive on one side and a strip that is releasable adhered to the adhesive. *See*, Declaration of Bonnie Pemberton at ¶11. The evidence shows that the claimed features responsible for the sales increase as opposed to other potential avenues such as advertising. Specifically, Ms. Pemberton testifies that the company doesn't spend a significant percentage of its budget on advertising and that the success of the product was because of the features. *See*, Declaration of Bonnie Pemberton at ¶14. Perhaps most telling, Appellants have sold over 1,500,000 packages of its product incorporating the invention since it was introduced in the market. *See*, Declaration of Bonnie Pemberton at ¶6.

Ms. Pemberton goes on to testify that she and her company were relatively inexperienced in the market before the success of the product and that the success of the product again was due to its features, and not her experience. *See*, Declaration of Bonnie Pemberton at ¶12.

The invention has been recognized in the industry with various awards. For example, in 1997 and 2003 the product incorporating the claimed invention won the "Editors Choice" award from Cat Fancy Magazine. Another example is the award for "Excellence" in 1999 from CATsumer Report. Still another example is the receipt of a formal "endorsement" from CATNIP! Newsletter in 1999. A further example is the "Seal of Approval" from the ASPCA in 2000. *See*, Declaration of Bonnie Pemberton at ¶13, Exhibits H, I and J.

The products incorporating the invention have been recommended in award-winning books, including:

- **Complete Kitten Care**, by **Amy D. Shojai**, a nationally known authority on pet care and behavior, a spokesperson for Purina®, and an award-winning author of more than a dozen nonfiction pet books.
- **Kittens for Dummies**, by **Dusty Rainbolt**, a nationally known authority on cat care and behavior, and an award-winning author and a regular contributor to the Whole Cat Journal and City + Country Pets.

- **The Cat Fanciers' Association Complete Cat Book**, by **Mordecai Siegel**, a nationally known, highly-regarded and widely published authority on pet care.
- **Think Like A Cat**, by **Pam Johnson-Bennett**, a Certified Animal Behavior Consultant and clinical member of the International Association of Animal Behavior Consultants. She is the author of a number of award-winning and critically acclaimed books and one of the country's most well-known and popular experts on cat behavior. *See*, Declaration of Bonnie Pemberton at ¶22.

Mr. Ruben testifies also that the claimed features of the invention have been mentioned to him favorably by customers large and small. Specifically, Mr. Ruben sets out that the features claimed in independent claims 1 and 42 among others are responsible for the success of the product. *See*, Declaration of Chris Ruben at ¶¶6-9.

The evidence also shows the nonobviousness of the invention by virtue of the close copying of the invention by at least two competitors. The first competitor is a larger, more well-established company than Appellants' company. *See*, Declaration of Bonnie Pemberton at ¶18, Exhibit D. Mr. Ruben also testifies that the product of the inventor incorporating the elements of the invention and at least one competitor's product move in the same channels of trade and are purchased by the same customers. *See*, Declaration of Chris Ruben at ¶5. For example, with respect to the first competitor, Appellants respectfully direct the attention of the Board to the virtual duplication of the product. The first competitor has copied the size and dimensions including the bisected release layer in its product. Moreover, in order to closely associate the competitive product with the product of Appellants' which incorporates the claimed invention, the first competitor has virtually copied the label and the instruction sheet, presumably in order to lead customers to believe that a competitive product incorporates the features of the claimed invention. *See*, Declaration of Bonnie Pemberton at ¶19, Exhibits A, D. The Board will also note that the competitive product does incorporate the claimed features of at least claim 1 including multiple layers and the bisected release layer. The instructions of the competitor

specifically point out the structure and function of the features of the claimed invention. The first competitor has also used a nontoxic adhesive similar to that claimed by the invention. *See*, Declaration of Bonnie Pemberton at ¶¶18-19, Exhibit C, E, K.

As another example, the second competitor has also copied Appellants' product incorporating the claimed invention. *See*, Declaration of Bonnie Pemberton at ¶¶20-21, Exhibits F, G.

The second competitor not only copies the bisected release layer but the structure of the claimed invention. Moreover, the second competitor adopts similar product packaging and instructions to those of the inventor to leverage the apparent similarity to the claimed invention. *See*, Declaration of Bonnie Pemberton at ¶¶20-21, Exhibits F, G.

In her Supplemental Declaration, Ms. Pemberton addresses comments made by the Examiner discounting the evidence in her earlier Declaration.

The Examiner takes the position that the invention was merely replacement of the prior art double sided tape offered by the 3M Company and further that it was merely a repackaging and remarketing of a previous product. Ms. Pemberton testifies that this is not correct at ¶2 of her Supplemental Declaration. Ms. Pemberton goes on at ¶2 to testify that the 3M tape product did not have the features of the invention such as a base release sheet, a bisected top release sheet and was not provided in flat strips. She further testifies that the invention was not a repackaging of the prior art, but was rather substantially different and is a substantial improvement over it.

The Examiner further implies without support that an important factor in determining market success was whether the 3M tape product was sold in pet stores. Ms. Pemberton testifies in ¶3 of her Supplemental Declaration that in fact, the Examiner placed prior art in the file which describes two publications showing that double sided tape, such as the 3M tape product were in

fact publicized as a use for a cat deterrent. *Also see, Basic Training for Your Cat*, <http://www.perfectpaws.com./train.html>; *Claws and All: Living With Your Cat, Your Furniture, and Your Peace of Mind*, <http://www.nsus.org/claws.html> filed in support of the Office Action dated September 22, 1998. This evidence of record increases the likelihood that the success of Appellants' invention was not due to merely novel packaging, but rather due to the advantages of the claimed features of the invention.

The Examiner goes on to imply that the resulting rise in sales of Appellants' invention was due to its advertising as a cat deterrent and not because of the claimed features of the invention. Ms. Pemberton testifies on this point that in the years of selling the product, not a single customer has indicated that the product was purchased because of the advertising or packaging and not because of the claimed feature of the invention. Further, she goes on to point out that the declaration of Mr. Chris Ruben, sales agent for the product, indicates that numerous customers have told him that the products were purchased because of the claimed features of the invention.

Finally, the Examiner suggests that the ASPCA seal of approval was given to the Appellants prior to incorporating the features of the invention in exchange for payment. Ms. Pemberton testifies that the ASPCA award is given only after scrutiny for the function of the product and safety to pets and that it is not a quid pro quo for donations received. *See*, Supplemental Declaration of Bonnie Pemberton at ¶4.

Ms. Pemberton testifies that the ASPCA scrutinizes pet related products to ensure claimed functionality and the safety of pets. Ms. Pemberton further testifies that products submitted for the Seal of Approval are reviewed by a panel of ASPCA experts comprised of veterinarians, veterinary toxicologists, animal behaviorists, and animal science specialists

nationally renowned in their scientific fields. (*See*, Supplemental Declaration of Bonnie Pemberton at ¶4). Ms. Pemberton further testifies that the ASPCA award is only given after a review of the product for quality and safety (*See*, Supplemental Declaration of Bonnie Pemberton at ¶4), and that it is a bona fide award awarded to the product incorporating the features of the invention.

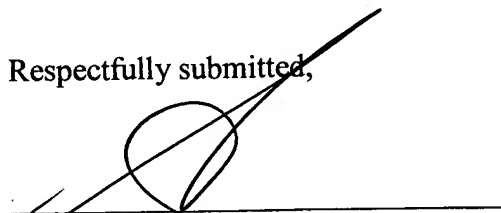
Conclusion

For the reasons set forth above, Appellants respectfully submit that the claims are in full compliance of the requirements of 35 U.S.C. § 112 and all of the claims at issue are patentable over the prior art under 35 U.S.C. §§ 102 and 103. Accordingly, it is respectfully requested that the final rejection of the claims at issue be reversed.

Enclosed is a check in the amount of \$250.00 to cover the fee for the filing of this Appeal Brief. The Commissioner is hereby authorized to charge any additional fee that may be due in connection with this Appeal Brief or to credit any overpayment to Deposit Account No. 50-2225.

Dated: March 14, 2007

Respectfully submitted,



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